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09/668,688	09/23/2000	Christopher Charles McCormick	Indigo 1	4264

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EXAMINER

SNAY, JEFFREY R

ART UNIT PAPER NUMBER

1743

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/668,688

Applicant(s)

MCCORMICK ET AL.

Examiner

Jeffrey R. Snay

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-17, 20, 22-25 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 24, "said uniform standard" lacks antecedent basis in the claims. Parent claim 20 does not require nor introduce the subsequently referred "uniform standard".

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 7 and 14-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by NIST WebBook (<http://webbook.nist.gov>).

The NIST WebBook identifies a chemical property database, compiled by a supplier independent testing facility (NIST), which properties are obtained in accordance to a supplier independent standard (i.e. determined by NIST). The NIST database is searchable, which inherently discloses the presently recited steps of receiving a requirement into the data processing system in the form of a search request, and

outputting an indicium of an identified batch in the form of a search result. The uniform standard established by the NIST Webbook system comprises name, chemical formula, CAS registry number, molecular weight, selected ion energetics and spectral properties.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-8, 20, 22-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art.

Applicant admits as known, at pages 2-3 of the specification, a method comprising evaluation by a supplier of a chemical batch in accordance with a standard and specification for that chemical. Such supplier, upon receipt of a requirement or request from a prospective purchaser then compares the requirement to the previously attained analysis to accommodate the request. See e.g. Figure 1A. Thus the conventional method as admitted by applicant differs from claim 1 only in that the step of comparing the purchaser request to inventory analysis is to be performed by a data processing system. It is well recognized that the provision of generic automated means for the purpose of performing a known step otherwise performed by hand is considered obvious to one of ordinary skill in the art. The provision in the admitted method of a computer processing system for the purpose of automating the step of comparing a purchaser request to available inventory would have been obvious and within the purview of the skilled artisan.

Regarding instant claim 3, it is noted that the recited limitation does not preclude the testing facility from being that of the supplier, which is the case of the admitted method. Regarding instant claims 4 and 5, it would have been obvious to one of skill in

the art to compile past purchaser statistics in order to direct future marketing and manufacturing practices, as was conventional in retail business operations.

Regarding instant claims 6 and 7, it is noted that the recited limitations of updating inventory information would have been inherent in the admitted method when applied to any chemical manufacturer that offers more than one chemical for market.

Regarding instant claim 8, it is noted that the recited limitation would have been met merely by the imposition of a sale on the part of the manufacturer.

Regarding new claims 20, 22, 23 and 25, these claims further recite that the data processing system compares the inputted requirement to at least two different suppliers. This limitation is further admitted by applicant as known, in the form of an independent, third party, testing facility, as is depicted in Figure 1B.

### ***Response to Arguments***

7. Applicant's arguments filed 10-15-2003 have been fully considered but they are not persuasive.
8. Applicant argues that the NIST disclosure teaches only a request for data, rather than the presently recited "requirement", which requirement is afforded a special definition by applicant's specification as including allowed ranges for certain chemical characteristics. However, the NIST webpage clearly states that in addition to being responsive to requests for data with respect to user identified chemicals, the user also has the option of searching the database by inputting desired properties - hence a "requirement".

9. Applicant further argues that the NIST webpage does not compare the requirement to identify a satisfactory batch available for sale. However, the NIST processing system responds to the user's inputted requirement by identifying a chemical that satisfies that requirement. The fact that NIST does not itself offer the located chemical for sale does not defeat the availability of purchase of the chemical from another supplier.

10. Applicant further argues that NIST does not output an indicium of the identified batch, but rather simply retrieves the requested property data for a specified compound. This is not persuasive for the same reasons set forth above in paragraph 8.

11. Applicant further argues that the NIST property data are not acquired in accordance with a uniform standard. First, it is noted that independent claim 1, neither expressly nor implicitly, requires a uniform standard. In any event, the NIST database establishes its own collection of properties to be included in the database, and thus inherently constitutes a uniform standard. Furthermore, the instant claims refer only to a single request, for a single chemical. Thus any standard for that singularly identified chemical would inherently, and by definition, have been uniform.

12. Applicant further argues, with respect to the rejections over the admitted prior art, that such admitted prior art teaches that a prospective purchaser provides a request for a chemical, rather than a requested "requirement". The argument is not persuasive. Whether a prospective purchaser identifies a desired chemical by name or by property, it is without question that it is in all cases the particular chemical properties that are desired. As such, any request by a prospective purchaser for a specialty chemical

inherently would include a "requirement" for the specifically desired properties of that chemical.

***Allowable Subject Matter***

13. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claim 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the presently recited method including comparing separate batches of a specialty chemical from at least two different suppliers, and in accordance with a uniform standard, in response to a prospective purchaser submitted "requirement".

***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

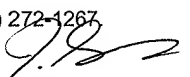


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267.



Jeffrey R. Snay  
Primary Examiner  
Art Unit 1743

jrs